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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 09/942,149 | 08/30/2001 | Maria Azua Himmel | AUS920010454US1 | 6541 |
| 7590 | 01/16/2004 | | EXAMINER | |
| Duke W. Yee Carstens, Yee & Cahoon, LLP P.O. Box 802334 Dallas, TX 75380 | | | CHEUNG, MARY DA ZHI WANG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/942,149 | HIMMEL ET AL. | |
| | Examiner Mary Cheung | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 January 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 7-12, it is not clear whether the claimed limitations (i.e. receiving from a client a request for a web document) are executed by the computer program as claimed in the preambles. Applicant is advised to include a limitation that clearly shows the claimed limitations are performed by using the computer program, such as adding the limitation of "the computer program comprising computer executable code to perform..." in the preamble of claim 7.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-2 and 6 only recite an abstract idea. The recited steps of merely receiving a request from a client for a web document and charging a party associated with the web document activity do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. In Bowman (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished)), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although Bowman discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea which is not tied to any technological art or environment. In the present case, claims 1-2 and 6 only constitute an idea how to charge a party according to the network activity of the client.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

invention receives a request from a client for a web document and charging a party associated with the web document activity (i.e. useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-2 and 6 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-5, 7, 9-11, 13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Moen et al., U. S. Patent 5,864,604.

As to claims 1, 7 and 13, Moen teaches a method, a computer program in a computer-readable medium, and a data processing system, comprising:

- a) Receiving from a client a request for a web document (abstract and column 6 lines 14-28 and column 7 lines 58-61; specifically, “*a request for a web document*” corresponds to the process to gain the access of the predetermined message in Moen’s teaching);
- b) In response to receiving the request, charging a party associated with the web document for subsequent network activity of the client (column 4 line 63 – column 5 line 15; specifically, “*a party*” corresponds to the sponsor in Moen’s teaching);

c) A bus system, a processing unit connected to the bus system and including at least one processor, memory connected to the bus system, and a set of instructions in the memory, wherein the processor unit executes the set of the instructions to perform the steps above (column 50 lines 50-62; specifically, *these limitations for the bus system, the processing unit, the memory correspond to the telecommunication network system in Moen's teaching*).

As to claims 3, 9 and 15, Moen teaches the client is a mobile computer (column 5 lines 31-37).

As to claims 4, 10 and 16, Moen teaches the mobile computer a portable digital assistant (column 5 lines 31-37).

As to claims 5, 11 and 17, Moen teaches the mobile computer is within a mobile telephone (column 5 lines 31-46).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 6, 8, 12, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moen et al., U. S. Patent 5,864,604 in view of Suzuki, U. S. Patent 6,493,763.

As to claims 2, 8 and 14, Moen teaches automatically accounting for access to web documents by the plurality of clients in a plurality of parties; in response to receiving a second request for a second web document, the web document is provided to the client, an appropriate amount is charged to a corresponding party (column 4 line 63 – column 5 line 15 and column 6 lines 14-28 and column 9 lines 5-14; specifically, *the web documents correspond to the predetermined messages in column 7 lines 55-65*).

Moen does not specifically teach in response to receiving a second request for a second web document that is not associated with the party, discontinuing charging the party for the network activity of the client. However, Suzuki teaches in response to a client service request for an information that is not associated with the sponsor party, discontinuing charging the sponsor party for the network activity of the client, and charging the client's account instead (column 5 lines 20-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Moen's teaching to include the feature of discontinuing charge the party for the network activity of the client if the web document requested by the client is not associated with

the party because this would result a fair and accurate accounting for both of the client and the party as enunciated by Suzuki (column 3 lines 6-11).

As to claims 6, 12 and 18, Moen teaches an appropriate amount is charged to the corresponding party based on the network activity of the client, and the measuring of the network activity comprising a pre-determined time interval, time of access and duration of access; and during the access, the allotted credit is decremented (column 4 line 63 – column 5 line 15 and column 6 lines 14-25, 58-60 and column 9 lines 15-21; specifically, “*a pre-determined time interval*” corresponding to the preset time period in column 6 lines 58-60). Moen does not specifically teach after a pre-determined time interval has elapsed, discontinuing charging the party for the network activity of the client. However, this matter is taught by Suzuki as discontinuing charge the sponsor party if the sponsor party is not responsible for network activity of the client (column 5 lines 20-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Moen’s teaching to include the feature of discontinuing charge the sponsor party for the network activity of the client if the pre-determined time interval has elapsed because this would result a fair and accurate accounting for both of the client and the sponsor party as enunciated by Suzuki (column 3 lines 6-11).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benyacar et al. (U. S. Patent 5,003,584) discloses a call billing method and apparatus specifies on a call-by-call basis, the calling charges incurred by a caller during a call to a sponsor-provided value-added service.

Goodman et al. (U. S. Patent 6,173,271) discloses when the advertisement is actually aired, the payment can be automatically transferred.

Trell (U. S. Patent 6,606,376) discloses entrance telephone communication utilizing public subscriber telephone networks, in which at least part of the subscribers connected to the entrance telephone system are arranged having a telecommunication subscription facilitating that the subscriber is billed for received and switched through entrance telephone calls, preferably with the charges shown in the conventional telephone bill with at least the call charges paid by sponsor.

Hamilton (U. S. Patent Application Publication: US 2002/0176377 A1) discloses providing a sponsored packet switched data service.

Sonoda (JP 2002135427 A) discloses providing a mobile phone advertisement system that can effectively utilize mobile phone terminals for advertisement.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung *Mary Cheung*
Patent Examiner
Art Unit 3621
January 5, 2004